REMARKS

Claim 33 is pending in the application. Claim 33 has been rejected.

Reconsideration and withdrawal of the rejections set forth in the Office action dated July 26, 2002 are respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is/are captioned **"Version With Markings to Show Changes Made."**

I. Amendments

Claim 33 has been amended to recite that the at least one retractable electrode is preformed to assume a curved shape when deployed. Support for this amendment can be found in the description of Figure 14 added on page 28, lines 21-22, and lines 25-27.

Accordingly, this amendment adds no new subject matter.

II. Rejections under 35 C.F.R. §102

Claim 33 was rejected under 35 U.S.C. §102(b) as allegedly anticipated by Rydell (U.S. Patent No. 5,007,908). This rejection is respectfully traversed.

A. The Present Invention

The present invention describes a probe system comprising an elongate member with distal and proximal ends, a handle at the proximal end, and an electrode deployment device positioned at least partially in the elongate member. The electrode deployment device includes at least one retractable electrode having a non-deployed state when positioned in the elongate member and being preformed to assume a curved shape when deployed. The electrode is advanceable in and out of the elongate member.

B. The Prior Art

RYDELL describes an electrosurgical instrument for cutting tissue and coagulating blood. The instrument of Rydell is used for surgical techniques such as enlarging the opening of the papilla for passing gall stones or for removing polyps from the colon. The instrument includes an elongated, flexible member with proximal and distal ends. A

plurality of lumens extend between the ends of the member. A bullet-shaped ceramic tip is affixed to the distal end of the member. The exterior surface of the tip is covered with a conductive layer forming a first electrode. The tip has a centrally disposed longitudinal bore in the side wall. In the "cut" mode, a wire is extended through the longitudinal bore and acts as the active electrode in a bipolar pair. An endoscope is used to locate the instrument through an appropriate body orifice to the body cavity where the surgery is to take place.

C. Analysis

According to the M.P.E.P. § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference".

Rydell fails to teach an electrode that is preformed to assume a curved shape when deployed. The electrode of Rydell is a simple, elongate wire that is movable longitudinally so that its proximal end projects outwardly through an opening formed in the tip of the elongated tubular member (Col. 1, lines 42-59). This electrode is deployed from the elongate member using a spring-loaded plunger, and when deployed is at an angle determined by the opening formed in the tip member. As the electrode is advanced further from the elongate member it does not alter direction from the angle determined by the opening (see Figs. 1 and 4).. Nowhere does Rydell teach that the electrode is or could be preformed to assume a curved shaped when deployed, as set forth in pending claim 33.

Accordingly, Applicants submit that the standard of strict identity to maintain a rejection under 35 U.S.C. §102 has not been met. Withdrawal of the rejections under 35 U.S.C. §102(b) is respectfully requested.

III. Rejections under 35 C.F.R. §103

Claim 33 was rejected under 35 U.S.C. §103 as allegedly obvious over either Abele *et al.* (U.S. Patent No. 5,403,311) or Durgin, Jr. *et al.* (U.S. Patent No. 5,336,222) in view of Rydell. This rejection is respectfully traversed.

A. The Present Invention

The present invention is described above.

B. The Prior Art

RYDELL is described above.

ABELE *ET AL.* describe a flexible, pushable, elongated electro-coagulation catheter. The distal tip of the catheter has a tissue-penetrable RF current electro-coagulation probe projectable from the catheter. The distal end of the catheter has a second electrode for contact with the tissue to operate in bipolar mode. The probe may further be a needle for delivery of fluid to the tissue.

DURGIN, JR. *ET AL.* describe an integrated catheter assembly for hemostatic, injection and irrigation therapies. The assembly includes a catheter with a bipolar electrode tip and an injection needle. The electrode tip has a body portion with a hemispherical distal end. The needle extends through a catheter lumen and the body portion.

C. Analysis

According to M.P.E.P. § 2143, one of the three basic criteria to establish a prima facie case of obviousness, is that "the prior art references (or references when combined) must teach or suggest all the claim limitations." It is Applicants' position that the references fail to teach or suggest all the claim limitations of the present invention.

As discussed above, Rydell fails to disclose an electrode that is preformed to assume a curved shape when deployed. The electrode of Rydell deploys longitudinally through a bore in the side wall of the bullet-shaped ceramic tip.

The disclosures of Abele *et al.* or Durgin, Jr. *et al.* do not make up for this deficiency. Abele *et al.* teach a retractable, rigid electro-coagulation needle or probe mounted on the distal end of a catheter. The probe is pushed through the opening in the catheter into the tissue. and is not preformed to assume a curved shape when deployed.

Durgin, Jr. *et al.* teach electrodes that are positioned on the exterior of the body portion, not extended therefrom. The electrodes are not positioned in the elongate member and do not deploy from the elongate member. Further, as the electrodes do not extend from the elongate member, they do not exhibit curvature.

The combined teachings of Rydell, Abele *et al.*, and Durgin, Jr. *et al.* nowhere show or suggest an electrode having a non-deployed state when positioned in the elongate member and being preformed to assume a curved shape when deployed.

Because none of the references alone or in combination teaches all the claim limitations of the present invention, the standard for obviousness has not been met. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103.

CONCLUSION

In view of the foregoing, Applicants submit that the claim pending in the application complies with the requirements of 35 U.S.C. §112 and patentably defines over the cited art. A Notice of Allowance is therefore respectfully requested.

The Examiner is invited to contact Applicants' representative at (650) 838-4410 if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

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Date: Sept. 26, 2002

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C

VERSION WITH MARKINGS TO SHOW CHANGES MADE

33. (Twice Amended) A probe system comprising:

an elongate member with a distal end and a proximal end;

a handle at the proximal end of the elongate member;

an electrode deployment device positioned at least partially in the elongate member and including at least one retractable electrode that is adapted to be inserted into tissue, is adapted to penetrate tissue, and is adapted to extend to a selected mass, [the]said at least one retractable electrode having a non-deployed state when positioned in the elongate member and [a distended deployed state when advanced from the elongate member is]being preformed to assume a curved shape when deployed; and

[the at least one deployed electrode has at least one radius of curvature;]

wherein the at least one electrode is advanceable in and out of the elongate member.